UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,088	08/01/2003	Gabor Bajko	59643-00290	3393

32294   7590   10/16/2008

SQUIRE, SANDERS & DEMPSEY L.L.P.
8000 TOWERS CRESCENT DRIVE
14TH FLOOR
VIENNA, VA 22182-6212

EXAMINER
NGUYEN, KHAI MINH

ART UNIT	PAPER NUMBER
2617	

MAIL DATE	DELIVERY MODE
10/16/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<table>
<tr><td rowspan="2">Office Action Summary</td><td>Application No.
10/632,088</td><td>Applicant(s)
BAJKO ET AL.</td><td></td></tr>
<tr><td>Examiner
KHAI M. NGUYEN</td><td>Art Unit
2617</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>26 June 2008</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-8,10-20 and 22-27</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-8,10-20 and 22-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

        1.☐ Certified copies of the priority documents have been received.

        2.☐ Certified copies of the priority documents have been received in Application No. _____.

        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date <u>8/4/2008</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-8, 10-20, and 22-27 have been

considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1-12 and 27 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The language of the claim raises a

question as to whether the claim is directed merely to an abstract idea that is not tied to

a technological art, environment or machine which would result in a practical application

producing a concrete, useful, and tangible result to form the basis of statutory subject

matter under 35 U.S.C. 101.

Claims 1-12 and 27, claims the non-statutory subject matter of a program. Data
structures not claimed as embodied in a computer readable medium are descriptive
material per se and are not statutory because they are not capable of causing functional
change in the computer. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1754
(claim to a data structure per se held nonstatutory). Therefore, since the claimed
programs are not tangibly embodied in a physical medium and encoded on a computer
readable medium then the Applicants has not complied with 35 U.S.C 101.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-8, 10-20, and 22-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herrero et al. (U.S.Pub-20050009520) in view of 3GPP TS 23.228 V6.1.0 (27 March 2003) .

Regarding claims 1 and 27, Herrero teaches a method/ a computer embodied on a computer-readable medium configured to control a processor comprising:

storing information regarding of relationships between a plurality of public and private identities associated with a subscription ([0038], [0093]) and of a control entity in which at least one of the identities is registered ([0038], [0094]);

allocating the control entity to a further registration based on the stored information ([0079]), and

Herrero fails to specifically disclose recognizing that different private identities associated with a common service profile. However, 3GPP teaches recognizing that different private identities associated with a common service profile (fig.4.5-4.6, section 4.3.3.4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teaching of 3GPP to Herrero to modify the information from which the home domain name is derived.

Regarding claim 2, Herrero and 3GPP further teach the method as claimed in claim 1, further comprising:

receiving a query from a further control entity for a registration status of a user (see Herrero, [0076], lines 1-6); and responding to the query by returning routing information configured to enable routing of a registration request to the control entity (see Herrero, [0077] and [0079]).

Regarding claim 3, Herrero and 3GPP further teach the method as claimed in claim 2, wherein the query which comprises an interrogating call state control function (see Herrero, [0067]) and the control entity comprises a servicing call state control function (see Herrero, [0067]-[0068]).

Regarding claim 4, Herrero and 3GPP further teach the method as claimed in claim 2, wherein the routing information comprises a name of the control entity (see Herrero, [0070]).

Regarding claim 5, Herrero and 3GPP further teach the method as claimed in claim 2, wherein the routing information comprises an address of the control entity (see Herrero, [0070]).

Regarding claim 6, Herrero and 3GPP further teach the method as claimed in claim 1, wherein the control entity comprise a plurality of control entities, and wherein the allocating further comprises selecting one of the plurality of the control entities (see Herrero, [0079]).

Regarding claim 7, Herrero and 3GPP further teach the method as claimed in claim 1, further comprising

recognizing that a user has an existing registration (see Herrero, [0079]).

Regarding claim 8, Herrero and 3GPP further teach a method as claimed in claim

1, further comprising

recognizing that different private identities associated with a common public

identity are associated with a subscription (see 3GPP, fig.4.5-4.6, section 4.3.3.4).

Regarding claim 10, Herrero and 3GPP further teach the method as claimed in

claim 1, further comprising

recognizing that different private identities associate with a common subscription

(see 3GPP, fig.4.5-4.6, section 4.3.3.4).

Regarding claim 11, Herrero and 3GPP further teach the method as claimed in

claim 26, wherein the user information storage comprises a home subscriber server

(HLR) (see Herrero, [0065], HSS).

Regarding claim 12, Herrero teaches a system comprising:

a plurality of control entities ([0094]);

a user information storage configured to store information ([0038]) of relations

between public and private identities associated with users of a communication system

([0038], [0093]) and of a control entity in which at least one of the public and privates

identities is registered (fig.1-2, [0038], [0094]); and

an allocating unit (fig.2) configured to allocate a call control entity to a further registration associated with a user based on the information stored in the user information storage ([0079]); and

Herrero fails to specifically disclose a recognizing unit configured to recognize at the user information storage that different private identities associate with a common service profile. However, 3GPP teaches a recognizing unit configured to recognize at the user information storage that different private identities associate with a common service profile (fig.4.5-4.6, section 4.3.3.4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teaching of 3GPP to Herrero to modify the information from which the home domain name is derived.

Regarding claim 13, Herrero teaches an apparatus comprising:

a storing unit configured to store information ([0038]) of relationships between public and private identities associated with users of a communication system ([0038], [0093]) and of a control entity in which at least one of the public and private identities is registered ([0038], [0094]);

an allocating unit (fig.2) configured to allocate the call control entity to a further registration associated with a user based on the information stored in the user information storage ([0079]); and

Herrero fails to specifically disclose a recognizing unit configured to recognize at the user information storage that two or more private identities are associated with a common service profile. However, 3GPP teaches a recognizing unit configured to

recognize at the user information storage that two or more private identities are

associated with a common service profile (fig.4.5-4.6, section 4.3.3.4). Therefore, it

would have been obvious to one having ordinary skill in the art at the time the invention

was made to apply the teaching of 3GPP to Herrero to modify the information from

which the home domain name is derived.

Regarding claim 14 is rejected with the same reasons set forth in clam 2.

Regarding claim 15 is rejected with the same reasons set forth in clam 3.

Regarding claim 16 is rejected with the same reasons set forth in clam 4.

Regarding claim 17 is rejected with the same reasons set forth in clam 5.

Regarding claim 18 is rejected with the same reasons set forth in clam 6.

Regarding claim 19 is rejected with the same reasons set forth in clam 7.

Regarding claim 20 is rejected with the same reasons set forth in clam 8.

Regarding claim 22 is rejected with the same reasons set forth in clam 10.

Regarding claim 23 is rejected with the same reasons set forth in clam 11.

Regarding claim 24, Herrero teaches a system, comprising:

a plurality of control entities ([0094]);

user information storage means for storing information ([0038]) of relations

between public and private identities associated with users of a communication system

([0068], [0093] lines 1-10) and of a control entity in which at least one of the public and

privates identities is registered ([0094]);

allocating means for allocating a call control entity to a further registration associated with a user based on the information stored in the user information storage means (fig.1-2, [0079]); and

Herrero fails to specifically disclose recognizing means for recognizing at the user information storage that different private identities associate with a common service profile. However, 3GPP teaches recognizing means for recognizing at the user information storage that different private identities associate with a common service profile (fig.4.5-4.6, section 4.3.3.4). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the teaching of 3GPP to Herrero to modify the information from which the home domain name is derived.

Regarding claim 25, Herrero teaches an apparatus for a communication system, the user information storage entity ([0042] lines 1-6) comprising:

storing means for storing information ([0038]) of relations between public and private identities associated with users of a communication system ([0038], [0093]) and of a control entity in which at least one of the public and private identities is registered ([0038], [0094]);

allocating means for allocating the call control entity to a further registration associated with a user based on the information stored in the user information storage ([0079]); and

Herrero fails to specifically disclose recognizing means for recognizing at the

user information storage that different private identities associate with a common

service profile. However, 3GPP teaches recognizing means for recognizing at the user

information storage that different private identities associate with a common service

profile (fig.45-4.6, section 4.3.3.4). Therefore, it would have been obvious to one having

ordinary skill in the art at the time the invention was made to apply the teaching of

3GPP to Herrero to modify the information from which the home domain name is

derived.

Regarding claim 26, Herrero and 3GPP further teach the method of claim 1,

wherein the method is performed by a user information storage (see Herrero, [0038]

and [0094]).

Conclusion

4.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to KHAI M. NGUYEN whose telephone number is

(571)272-7923. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Vincent P. Harper can be reached on 571.272.7605. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/VINCENT P. HARPER/
Supervisory Patent Examiner, Art Unit 2617

/Khai M Nguyen/
Examiner, Art Unit 2617   4/1/2008